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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,773

07/20/2004

Karl Kolter

53272

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03/04/2009

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EXAMINER

HAIDER, SAIRA BANO

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10501773	7/20/2004	KOLTER ET AL.	53272

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EXAMINER

SAIRA HAIDER

ART UNIT	PAPER
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1796

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DATE MAILED:

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Commissioner for Patents

As per the BPAI Order Returning Undocketed Appeal to Examiner (02/10/2009) attached are the following:

1. A full certified English language translation of the foreign reference Gotsche et al. (WO 00/18375).
2. Examiner's Answer wherein the citations to the Gotsche reference are based on the attached certified English translation.
3. PTO-892 indicating the attached certified English translation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saira Haider whose telephone number is (571) 272-3553. The examiner can normally be reached on Monday-Friday from 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached at (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Saira Haider
Examiner
Art Unit 1796



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/501,773
Filing Date: July 20, 2004
Appellant(s): KOLTER ET AL.

Michael P. Byrne
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/22/2008 appealing from the Office action mailed 12/10/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 00/18375	Gotsche et al.	4-2000
US 5,091,185	Castillo et al.	2-1992
US 4,842,854	Babaian et al.	6-1989

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1, 2, 5, 10, 20, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Gotsche et al. (WO 00/18375) (citations are based on the certified English translation of the Gotsche et al. reference).

In reference to claim 1, Gotsche discloses a coating agent, binder or film-forming excipient composition for solid substrates (page:lines :: 4:2-10). Wherein the composition is comprised of Component A: a graft copolymer of polyvinyl alcohol and polyether (formed via polymerization of one vinyl ester of aliphatic C₁-C₂₄ carboxylic acids in the presence of a polyether) (7:1-11), and Component B: an additional polymer (24:7-13).

It is noted that applicants recognize that the herein claimed polyvinyl alcohol-polyether graft copolymer is obtained by polymerizing (a) at least on vinyl ester of aliphatic C₁-C₂₄ carboxylic acids in the presence of a polyether (appellant's specification PG PUB at [0010-0012]). Thus, Component A is clearly disclosed by Gotsche.

In reference to component B, Gotsche discloses that the graft copolymer can be combined with additional polymers, wherein the ratio of the graft copolymer to the additional polymer is 1:9 to 9:1 (24:7-13). The examiner recognizes that Gotsche discloses, as an alternate embodiment, the inclusion of the additional polymer; as per MPEP § 2123, alternate embodiments constitute prior art. As discussed above, the reference anticipates the claimed graft copolymer species, thus anticipates, in an alternate embodiment, the claimed invention.

In reference to claims 2, 5, and 10, component B is a polymer; suitable compounds include the elected species of polyvinyl alcohols, polyvinylpyrrolidones and polyvinylpyrrolidone copolymers (24:7-13).

In reference to claim 20, regarding component C, Gotsche discloses that the graft copolymer can be applied in pure form or else together with conventional excipients to the substrate, including colored pigments, such as titanium dioxide (23:22 to 24:6), wherein the weight percentage of the conventional excipients in the composition is exemplified as 3 wt % (Example 7, see amount of titanium dioxide).

In reference to claim 27-28, Gotsche discloses that solid substrates can be coated with the coating agent disclosed above. Additionally, the substrate can be a pharmaceutical formulation, such as tablets (4:1-10).

Claim Rejections - 35 USC § 103

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gotsche et al. as applied to claim 1 above, and further in view of Castillo (US 5,091,185).

Gotsche fails to disclose that component B is a polyvinyl alcohol having a degree of hydrolysis of between 80 and 90 mol%. Hence attention is directed towards the Castillo reference, which discloses solid pellets of the biologically active materials coated with a composition comprising polyvinyl alcohol (PVA), wherein the polyvinyl alcohol preferably has a degree of hydrolysis greater than about 95% (col. 2, lines 35-55). Gotsche and Castillo are analogous art because they are from a similar problem solving area, coating solid pharmaceutical materials. At the time of the invention, it would have been obvious to a person of ordinary skill

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in the art to replace Component B of Gotsche with the hydrolyzed PVA of Castillo. The motivation to do so, as taught by Castillo, is employ the hydrolyzed PVA in order to effectively control the release of the active material after implantation to provide a more uniform rate of delivery over a longer period of time as compared to uncoated pellets (col. 2, lines 35-55).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gotsche et al. (WO 00/18375) as applied to the claims above, and further in view of Babaian et al. (US 4,842,854).

Gotsche fails to disclose that component B comprises vinylpyrrolidone-(meth)acrylate copolymers. Thus attention is directed towards the Babaian reference, which is drawn to pharmaceutical film composition. The film of Babaian comprises vinylpyrrolidone, or a copolymer thereof with an acrylate, wherein the film is recognized as a biologically soluble and resolvable carrier. Specifically, the disclosed film is mouth mucosa soluble, swellable and resolvable polymeric film-forming carrier (col. 16, line 61 to col. 17, line 4; claim 1). It is noted that, for component B, Gotsche discloses that suitable film formers include polyvinylpyrrolidone and polyvinylpyrrolidone copolymers (24:7-13). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize vinylpyrrolidone-acrylate copolymer as component B in the invention of Gotsche, as taught by Babaian. The motivation includes utilization of a mouth mucosa soluble, swellable and resolvable polymeric film-forming carrier.

Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gotsche et al. (WO 00/18375).

Gotsche applies as above, however, fails to disclose that component C is present in at least 5 wt % of the composition. It is noted that Gotsche exemplifies the weight percentage of the conventional excipients (component C) in the composition as 3 wt % (Example 7 and 8). However, Gotsche discloses that the examples of conventional excipients include white pigments such as titanium dioxide which increase the hiding power, in addition to mentioning other suitable excipients and their advantages (23:22 to 24:6). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to increase the amount of any of the conventional excipients mentioned by Gotsche in order increase the respective advantages, such as increase the hiding power, increase non-sticking, or to further improve the wetting characteristics. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

(10) Response to Argument

Appellants have argued that the Gotsche fails to anticipate the claimed invention, because in order to arrive at the claimed invention appellants have to select component A, select component B, and then combine components A and B.

In response, in reference to component A, appellant has claimed the genus polyvinyl alcohol-polyether graft copolymer, wherein the reference discloses a graft copolymer genus of polyvinyl alcohol and polyether (Gotsche at 7:5 to 8:11). The reference discloses formation of

the copolymer via polymerization of the same exact components as disclosed by appellant in the instant specification (PG PUG of the instant application at [0010-0012]). Furthermore, given that appellant has claimed a genus and the reference has disclosed the genus, the component is anticipated and species selection is not required for component A.

In reference to component B, appellant has claimed an additional polymer with at least one of the claimed functional groups (component B), wherein the reference discloses the claimed additional polymers within a listing of eleven species (Gotsche at 24:7-13).

It is noted that three of the eleven disclosed species in the prior art read on the species claimed in the instant dependent claims. The limited class of 11 compounds, three of which are claimed (claims 5 and 10) is considered anticipation because one skilled in the art would readily envisage each member of the limited class. Thus, given that the reference clearly names the more than one of the claimed species, component B is anticipated.

Appellants have argued that it is necessary to select portions of the teaching within a reference and combine, thus, appellants argue, the claims are not anticipated by the prior art Gotsche. In response, Gotsche discloses as an alternate embodiment the inclusion of additional polymers (Component B), wherein as per MPEP § 2123, alternate embodiments constitute prior art. Thus, it is clear that the Gotsche reference discloses the claimed invention as arranged in the claim.

In reference to the 103(a) rejection of claim 7, appellant has argued that no teaching, suggestion, or motivation exists to combine the references. In support of their argument, appellants have stated that Gotsche is drawn to coatings with the instant release of the active

material, wherein the Castillo reference is drawn to extended release coatings. The examiner has thoroughly considered the arguments and support provided, and concludes that the rejection is valid. The invention of Gotsche is drawn to a coating agent, binder and/or film-forming excipient in pharmaceutical presentations (4:1-4). Although, Gotsche discusses the instant release of the active material, the reference teaches that the rate of release of the active ingredient can be adjusted by the film coating (4:9-10). Thus, Gotsche teaches modification of the rate of release and the Castillo reference, as discussed in the rejection above, teaches a specific component utilized to control the rate of release of a film coating on a pharmaceutical presentation.

Appellants have argued that Castillo reduces the rate of release, however, col. 5, lines 29-38 of Castillo indicate that a fully hydrolyzed polymer has a high degree of water resistance and dissolve very slowly at particular temperatures. Thus, it is clear that a fully hydrolyzed polymer will indeed reduce the rate of release, but clearly, it teaches that polymers less than 100% hydrolyzed will result in a increase in the rate of release. Appellants argument regarding the claim limitation "quick dissolving" release is not of substantial weight given that appellants have failed to claim what exactly defines "quick dissolving." Furthermore, this limitation is considered an inherent property of the claimed invention, wherein given that the prior art discloses the claimed composition in the claimed amounts it is inherent that that the composition will be rendered "quick dissolving."

Appellant has argued that the instant specification discloses synergistic effects unforeseen by the Gotsche reference. In response, as per MPEP § 2131.01, evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179

USPQ 421, 425 (CCPA 1973). Thus, the results cannot overcome the 102(b) rejection. Further, the results are insufficient to overcome the 103 rejections because the evidence fails to overcome the basis of the prima facie case of obviousness. The prima facie case of obviousness is based on utilizing hydrolyzed PVA; however appellants' evidence is based on the combination of components A and B. The primary reference anticipates the combination of components A and B, thus the showing is insufficient to overcome the prima facie case of obviousness. Attention is directed to MPEP § 716.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/James J. Seidleck/

Supervisory Patent Examiner, Art Unit 1796

/Saira Haider/

Examiner, Art Unit 1796

Conferees:

/James J. Seidleck/

Supervisory Patent Examiner, Art Unit 1796

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796